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09/604,696	06/26/2000	Philip Carragher	Carr-P1-00	4961

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Peter K Trzyna  
P O Box 7131  
Chicago, IL 60680-7131

EXAMINER

KARMIS, STEFANOS

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/604,696

Applicant(s)

CARRAGHER ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/12/2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim numbers 26 and 27 are repeated. The claims should be numbered from 1-31.  
Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.

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3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 2, 4, 5, 9-15, 20-22, 26(line 17), and 27(line 29) are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson US Pat No. 6,070,153 in view of McMullin US Pat No. 6,222,914.

Claim 1, Simpson teaches a system and method for automatically funding an investment account based on credit card activity. "A portion of either the amount charged to the credit card for the purchase of goods and services or a portion of the interest paid on the outstanding balance of the credit card- or combination thereof- would be invested each month in the Investment Account" (column 1, lines 54-58). "The monthly credit account statement will include an IRA or Investment Account Statement showing the accounts' status" (column 5, lines 28-30). These transactions are facilitated with the use of a computer with data processing means (column 6, lines 57-59).

Claims 2, 4, and 5, Simpson teaches communication of the transaction to the cardholder on the monthly credit account statement (column 5, lines 28-29). The transaction is communicated to the investment company by a joint statement to reflect the account activity, when a cardholder performs a payment.

Claim 15, Simpson teaches "under the control of the computer, automatically calculating an amount to be contributed by the offering entity to the cardholder/investor's investment account by applying said selected percentage to the amount of interest charged to the cardholder/investor to establish an investment amount and automatically investing said

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investment amount on behalf of and for the credit of the cardholder/investor into the investment account and automatically issuing a statement to the cardholder/investor indicating said invested amount the balance and activity in the credit account and the balance and activity in the investment account” (column 7, lines 9-20).

Claim 26(line 17) and claim 27(line 29), Simpson teaches “(a) central computer means with associated data storage means, data processing means and data input means; (b) the data processing means, including means to establish a predetermined percentage of interest charged to the credit cardholder/investor; (c) the central computer means including purchase tabulating means for automatically receiving and entering into the data storage means records of purchases and advances made by the credit cardholder/investor during a first preselected period, and for calculating a sum of total purchases and advances made during such first preselected period; (d) the central computer means, including means for receiving and entering into the data storage means the amount of interest charged to the cardholder/investor for a second preselected period; (e) the central computer means automatically calculating an investment amount to be transferred to an investment account based upon the amount of interest charged to the credit cardholder/investor by applying said predetermined percentage of interest to said amount of interest; and (f) the central computer means including means for automatically transferring said investment amount to the investment account and for automatically issuing to the credit cardholder/investor a statement showing said investment amount” (column 7, lines 27-52).

Simpson fails to teach a system where credit card payments are used to assist in funding a mortgage payment.

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McMullin teaches a system and method for administration of an incentive award system for various embodiments such as a mortgage payment (column 5, line 67).

It would be obvious to anyone of ordinary skill in the art that combining the teachings of Simpson and McMullin would achieve a card rebate system directed towards mortgage payments.

Claims 9 and 12, Simpson teaches alternative investment opportunities for allocating the funds, such as Super IRA, Spousal IRA College Savings Account, 401(K), and others (column 1, lines 46-51).

Claim 10 13, and 20, Simpson teaches that the cardholder “could also make optional additional investments to the Investment Account” (column 2, lines 17-18).

Claim 11 and 14, “A portion of either the amount charged to the credit card for the purchase of goods and services or a portion of the interest paid on the outstanding balance of the credit card- or combination thereof- would be invested each month in the Investment Account” (column 1, lines 54-58).

Simpson fails to teach that both the cardholder and the mortgage company can make the decisions for allocation of funds. Official Notice is taken. It is obvious to anyone of ordinary skill in the art that any designation of payment rules could be directed from either the cardholder or the biller.

Simpson fails to teach the ability to have a second card activity also associated with the investment opportunity.

Clam 21 and 22, Official Notice is taken. It would be obvious to anyone of ordinary skill in the art, that a plurality of credit cards can be associated with funding the investment opportunity. As with the preferred embodiment, the plurality of cards would also receive communication of activity in the form of statement, as is the standard in the art.

5. Claims 3, 6, 7-8, 17-19, 24, 25, 26(line 4), 27(line 9), 28 and 29, are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson US Pat No. 6,070,153 in view of McMullin US Pat No. 6,222,914 in view of Hilt et al. US Pat No. 6,408,284 (hereinafter Hilt).

Simpson teaches a direct payment method through a computer network based on card activity to fund an investment account.

McMullin teaches incentives based on card purchases for mortgage payments.

Simpson and McMullin fail to teach the use of a coupon and payment check towards the mortgage payment.

Claims 3, 6, 25 and 28, Hilt teaches "the payment coupons which a biller requests to be returned with the consumer's check..."(column 1, lines 48-49). Payments coupons are received along with the check in an envelope (column 1-2, lines 67-1). The necessary information is may be provided on the coupon in a bar code or other form (column 1, line 53-54).

"A computer readable medium including at least computer readable code thereon for allowing a consumer to pay a bill, said computer readable medium comprising: computer

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readable code to forward a bill pay order to a first processor, said bill pay order including information identifying a biller, an amount owed, and a consumer-biller account number; computer readable code to determine whether said consumer has sufficient funds to cover said amount owed; computer readable code to compare said information identifying said biller to a local biller file to determine a biller financial institution identification number for a financial institution designated to receive funds for said biller; computer readable code to generate a payment message including said information identifying said biller, said amount owed, said consumer-biller account number, and said biller financial institution identification number; computer readable code to forward said payment message to a network if said computer readable code to determine whether said consumer has sufficient funds is satisfied; and computer readable code to route said payment message to said biller financial institution over said network using said biller financial institution identification number” (column 22-23, lines 57-15).

Claim 26(line 4), Hilt teaches “Consumer C must individually address, mail and track payments to individual billers such as biller B” (column 5, lines 47-48).

Claim 27(line 9), The bill pay system sends a related confirmation of receipt which is typically done electronically but can also be in paper form through a statement and mailing with an envelope (column 6, lines 56-60).

Claims 17 and 19, Hilt teaches “At some time following the clearing of check 44, biller B also updates its A/R records in G/L database 42 to credit consumer C's C-B account, and Bank C confirms to consumer C the withdrawal of the amount of check 44 by listing it on statement” (column 5, lines 36-39).



“If the bill pay transaction goes through, Bank C will confirm that it went through by sending a confirmation (typically statement 38) to consumer C” (column 8, lines 6-8).

Claim 24, Hilt teaches “A computer readable medium as recited in claim 1, wherein said computer readable code to compare said information to a local biller file comprises: computer readable code to verify said information identifying said biller” (column 23, lines 24-27).

Claim 29, Hilt teaches, “a consumer transmits to its bank a bill pay order indicating a payment date, payment amount...” (Abstract).

Claim 7, 8, 18, Hilt teaches payment messages might also include additional information which is to be passed between consumer C, biller B and Bank V and Bank B, in an agreed-upon format, to effect financial transaction (column 14, lines 51-56).

Hilt fails to teach forecasting final payments. Official Notice is taken. It would be obvious to anyone of ordinary skill in the art that the billing statement would contain all pertinent information regarding the account, including payment timelines, and interest calculations.

6. Claims 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson US Pat No. 6,070,153 in view of McMullin US Pat No. 6,222,914 in view of Burke US Pat No. 6,088,682.

Simpson teaches credit card activity to fund an investment account.

McMullin teaches incentives based on card purchases for mortgage payments.

Simpson and McMullin fail to teach card activity to transfer funds to a charity organization.

Burke teaches a fund distribution system connected with point of sale transactions.

Claim 16 and 23, Burke teaches a process that allocates the change, or portion of the change selected by the consumer, among various charity accounts (column 3, lines 26-28). "The register furnishes the SP with a printed receipt of each donation for tax purposes and authentication that the charity will receive the money" (column 12, lines 63-65).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Robinson et al. US Patent 5,734,838 Mar. 31, 1998. Database computer architecture for managing an incentive award program and checking float of funds at time of purchase.

b) Boyer et al. US Patent 6,208,973 Mar. 27, 2001. Point of service third party financial management vehicle for the healthcare industry.

c) Shurling et al. US Patent 6,424,951 Jul. 23, 2002. Data processing technique for scoring bank customer relationships and awarding incentive rewards.

d) Walker et al. US Patent 6,434,534 Aug. 13, 2002. Method and system for processing customized reward offers.

e) Freeman et al. US Patent 6,450,407 Sept. 17, 2002. Chip card rebate system.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-1113.

Respectfully Submitted  
Stefano Karmis  
Art Unit 3624  
December 12, 2002



**HANI M. KAZIMI**  
**PRIMARY EXAMINER**

# CLAIM DIAGRAM

